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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,905	05/24/2001	Craig Harrison Miller	627-3271P	3099

7590 05/19/2003

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EXAMINER

LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/19/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,905

Applicant(s)

MILLER ET AL.

Examiner

Hong Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 13-15, 17-25, 27-31, 33-36 and 38-42 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

- 5) ☒ Claim(s) ____ is/are allowed.

- 6) ☐ Claim(s) 1-4, 6-10, 13-15, 17-25, 27-31, 33-36 and 38-42 is/are rejected.

- 7) ☐ Claim(s) ____ is/are objected to.

- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

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DETAILED ACTION

Claims 1-4, 6-10, 13-15, 17-25, 27-31, 33-36, and 38-42 are pending in this application.

This action is in response to the applicants' amendment and reply filed on March 17, 2003.

Response to Arguments

Applicants' arguments filed on March 17, 2003 have been fully considered but they are not persuasive. Rejection to Claims 1-4, 6-10, 13-15, 17-25, 27-31, 33-36, and 38-42 is maintained for the reasons given bellow.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

The amended claims are object to as they still contain the non-elected subject matter. As it was indicated in the previous office, the core structure of the elected species is diazabicyclo[3,31]nonane and the structure search was based on this structure. Therefore, in order to obtain allowable claims, applicants have to amend the claims in such a way that the scope of the claims is consistent with what has been searched. Claims 1, 12, 22, and 33 have to be further restricted to compounds with a diazabicyclo[3,31]nonane core.

Claim Rejections - 35 USC § 112

The rejection to claims under 35 U.S.C., 112, first paragraph, is hereby withdrawn in view of applicant's amendment and argument.

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Rejections 2) and 3) under 35 U.S.C. 112, second paragraph, are maintained for reasons already made of record in the previous office action. Applicants argue that the terms such as “heterocyclyl” and “substituted” can be found in the specification and thus are not in definite. The Examiner noted that there is no specific definition for the term “substituted” in the specification. As for the term “heterocyclyl,” reading a claim in light of the specification is quite different from reading limitations of the specification into the claim. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541. These claims themselves do not carry the limitation as specified in the specification. When the claims having these terms are given the broadest interpretation, they are still open-ended in terms of the array of heteroatoms, size of the rings, as well as nature of atoms as ring members of the heterocycles.

The remaining rejections under 35 U.S.C. 112, second paragraph, are hereby withdrawn in view of the amendments.

Claim Rejections - 35 USC § 103

Claims 1-10, 12-31, and 33-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Czollner et al. (WO 97/40049). Although applicants have amended the claims to define the substituent attached to one of the nitrogens in the bicyclic ring to be H, the claims are still rendered obvious by the reference because R22 of the reference can be methyl. Me v. H is not deemed patentably distinct in the absence of superior or unexpected properties. See *In re Wood* 199 USPQ 137; *In re Lohr* 137 USPQ 548 regarding the addition of a Me group to a known compound. Furthermore, applicants should note a replacement of two hydrogen atoms on a known compounds with two lower alkyl radicals has been held to be prima facie obvious due to

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the close structural similarity. Note *In re Hoke*, 195 USPQ 148 and *Ex parte Fauque*, 121 USPQ 425. Thus, it would have been obvious to one skilled in the art at the time the instant invention was made to expect instant compounds to possess the same use as the applied art in view of the close structural similarity outlined above.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the

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status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl

May 14, 2003



Mukund Shah
Supervisory Patent Examiner
Art Unit 1624